

SECTION II (REMARKS)

I. SUMMARY OF AMENDMENTS

Independent claims 1, 8, 15, and 22 have been amended herewith to help clarify that the notification “indicat[es] that said advertisement on said first channel must be viewed.” Such amendment is supported by the specification, for example, at page 11 (e.g., referring to “the ability to switch channels will not be taken from the viewer until the expiration of the selected period of time after the viewer has received notification that the advertisements must be viewed”). Applicant submits that the term “notification” in claims 1, 8, 15, and 22 as previously presented is clear to one skilled in the art based on plain language of the claims and in view of the specification – and that such claims are fully compliant with 35 U.S.C. 112 without the foregoing amendments – but that the amendments requested herein may enhance clarity of the claims.

II. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN

The August 27, 2009 Office Action contained multiple claim rejections under 35 U.S.C. 103, namely:

- a rejection of claims 1-3, 8-10, 15-17, and 22-24 as being unpatentable for obviousness over U.S. Patent Application Publication No. 2001/0054181 to Corvin (hereinafter, “Corvin”) in view of U.S. Patent Application Publication No. 2007/0067800 to Wachtfogel (hereinafter, “Wachtfogel”), in further view of U.S. Patent Application Publication No. 2002/0144262 to Plotnick et al. (hereinafter, “Plotnick”);
- a rejection of claims 4-16, 11-13, 18-20, and 25-27 as being unpatentable for obviousness over Corvin in view of Wachtfogel and Plotnick, further in view of U.S. Patent No. 6,993,727 to De Ceulaer (hereinafter, “De Ceulaer”); and

- a rejection of claims 7, 14, 21, and 28 as being unpatentable for obviousness over Corvin in view of Wachtfogel, Plotnick, and De Ceulaer, further in view of U.S. Patent No. 5,943,605 to Koeppele (“Koeppele”).

Such rejections are traversed in application to the claims as amended herewith.

A. *The Rejections of Claim 1 and The Claims Depending Therefrom Should be Withdrawn*

With respect to independent claim 1, the August 27, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification¹. ” In seeking to remedy this deficiency in Corvin’s disclosure, the Office Action alleges that Wachtfogel discloses “in response to a first control signal² and allowing the switching in response to a second control signal³, the second control signal being provided at an end of the video program⁴” and that Plotnick discloses “wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification⁵. ” Applicant respectfully disagrees with the examiner’s characterization of Wachtfogel and Plotnick in this regard.

The examiner is mistaken in asserting that paragraphs 0173, 0181 of Wachtfogel disclose any “first control signal” within the meaning of Applicant’s claim 1. Paragraph 0173 of Wachtfogel refers to a commercial set of parameters (which characterize the commercial) as including “(2) expiration after a predetermined number of people have seen the commercial.” Paragraph 0181 of Wachtfogel states in relevant part that

¹ See August 27, 2009 Office Action, page 4.

² The examiner cited “Paragraph 0173, 0181” of Wachtfogel in support of this point (August 27, 2009 Office Action, page 4).

³ The examiner cited “Paragraph 0182-0184” of Wachtfogel in support of this point (August 27, 2009 Office Action, page 4).

⁴ The examiner cited “Paragraphs 0170, 0181-0182 of Wachtfogel in support of this point, and equated the “second control signal being provided at the end of the video program” to “each commercial includes set of parameters, wherein commercials are provided at end of program” as allegedly disclosed by Wachtfogel (August 27, 2009 Office Action, page 4).

⁵ The examiner cited Paragraph 0229 of Plotnick in support of this point (August 27, 2009 Office Action, page 5).

“[p]referably, the parameter disabling the option of “fast-forward/fast-backward” when the commercial is displayed may be employed to prevent situations in which the user watches a movie and skips the commercial, the commercial being preferably associated with the movie.” Paragraphs 0173 and 0181 of Wachtfogel thus disclose a situation wherein (e.g., default) disablement of ‘fast-forward/fast-backward’ while a commercial is displayed may expire upon attainment of a specified condition. Wachtfogel’s expiration of a (fast-forward/fast-backward) disablement feature is NOT a “first control signal” within the meaning of Applicant’s claim 1, since the plain language of claim 1 requires that “*an advertisement is displayed on said first channel in response to a first control signal.*” Nothing in Wachtfogel paragraphs 0173 or 0181 discloses any “first control signal” that causes display of an advertisement on a first channel.

The examiner is also mistaken in asserting that paragraphs 0182-0184 of Wachtfogel disclose “allowing [of] switching in response to a second control signal” within the meaning of Applicant’s claim 1. Applicant’s claim 1 refers to switching from a first channel to a second channel. Paragraphs 0182-0184 of Wachtfogel refer to disablement or enablement of “fast-forward/fast-backward” functions, not to allowing of “switching from a first channel to a second channel” as required by Applicant’s claim 1.

The examiner is further mistaken in asserting that paragraphs 0170, 0181, and 0182 of Wachtfogel disclose any second control signal “provided at an end of the video program” within the meaning of Applicant’s claim 1. Paragraph 0170 of Wachtfogel states that “[p]referably, the additional attributes are assigned to the commercial by the broadcaster by associating a commercial set of parameters to the commercial in addition to the above mentioned broadcaster set of parameters.” Paragraph 0181 of Wachtfogel states in relevant part that “[p]referably, the parameter disabling the option of “fast-forward/fast-backward” when the commercial is displayed may be employed to prevent situations in which the user watches a movie and skips the commercial, the *commercial being preferably associated with the movie.*” Paragraph 0182 of Wachtfogel states in relevant part that “[p]referably, the parameter disabling the option of ‘fast-forward/fast-backward’ when the commercial is displayed may be employed only until the user has seen the commercial a predetermined number of times in a predetermined time period, such as a week, or a predetermined number of commercials in the predetermined time

period.” The mention in Wachtfogel paragraph 0181 of as association between a commercial and a movie does not compel the examiner’s conclusion that Wachtfogel disclose any “second control signal being provided at an end of the video program” within the meaning of Applicant’s claim 1. Wachtfogel’s airing of a commercial in proximity to a movie does not constitute a “second control signal” that allows switching between channels as required by Applicant’s claim 1.

Plotnick relates to a system for presenting a viewer with an alternative brief version of an advertisement (a so-called “trick play” advertisement, such as a static screen presenting a logo or portion of the commercial, a condensed version of the actual advertisement, or an alternate or entirely unrelated advertisement) when the viewer chooses to fast-forward through a commercial⁶. In one embodiment, the viewer sees the fast-forwarded commercial in one portion of the screen while the alternative brief version is displayed⁷.

In comparing Plotnick to Applicant’s claim 1, the examiner pointed to paragraph 0229 of Plotnick as disclosing that a “start of advertisement notifies user and user is prevented from switching if the ad progresses too far.” Amended claim 1 requires (*inter alia*) that “the viewer is prevented from the switching after expiration of a selected period of time after a notification indicating that said advertisement on said first channel must be viewed.” Nothing in Plotnick (or any other references relied upon by the examiner) discloses or suggests any notification indicating that an advertisement on a channel must be viewed. Mere starting of an advertisement as disclosed by Plotnick does not embody any notification that the advertisement must be viewed.

The foregoing arguments demonstrate that Wachtfogel and Plotnick fail, in multiple respects, to remedy the deficiencies of Corvin in disclosing the features of Applicant’s amended claim 1. Based on the failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 1 under 35 U.S.C. 103 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims

⁶ See Plotnick, ¶ [0059].

⁷ Id.

on which they depend⁸, the claims depending (whether directly or indirectly) from claim 1 are likewise distinguished over the cited art. Withdrawal of the rejections of all claims depending from claim 1 is warranted, and is respectfully requested.

B. *The Rejections of Claim 8 and The Claims Depending Therefrom Should be Withdrawn*

In the August 27, 2009 Office Action, the rejection of independent claim 8 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 8.

The August 27, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification⁹. ”

It has been previously established herein that Wachtfogel fails to disclose “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program” and that Plotnick fails to disclose “wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification indicating that said advertisement on said first channel must be viewed.”

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 8 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend¹⁰, the claims depending (whether directly or indirectly) from claim 8 are likewise distinguished over the cited art.

⁸ 35 U.S.C. 112, fourth paragraph.

⁹ See August 27, 2009 Office Action, page 4.

¹⁰ 35 U.S.C. 112, fourth paragraph.

C. The Rejections of Claim 15 and The Claims Depending Therefrom Should be Withdrawn

In the August 27, 2009 Office Action, the rejection of independent claim 15 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 15.

The August 27, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification¹¹. ”

It has been previously established herein that Wachtfogel fails to disclose “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program” and that Plotnick fails to disclose “wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification indicating that said advertisement on said first channel must be viewed.”

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 15 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend¹², the claims depending (whether directly or indirectly) from claim 15 are likewise distinguished over the cited art.

D. The Rejections of Claim 22 and The Claims Depending Therefrom Should be Withdrawn

In the August 27, 2009 Office Action, the rejection of independent claim 22 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection

¹¹ See August 27, 2009 Office Action, page 4.

¹² 35 U.S.C. 112, fourth paragraph.

with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 22.

The August 27, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification¹³.”

It has been previously established herein that Wachtfogel fails to disclose “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program” and that Plotnick fails to disclose “wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification indicating that said advertisement on said first channel must be viewed.”

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 22 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend¹⁴, the claims depending (whether directly or indirectly) from claim 22 are likewise distinguished over the cited art.

E. The Rejections of Dependent Claims 4-6, 11-13, 18-20, and 25-27 Should be Withdrawn

In the August 27, 2009 Office Action, claims 4-16, 11-13, 18-20, and 25-27 were rejected under 35 U.S.C. 103 as being unpatentable for obviousness over Corvin in view of Wachtfogel and Plotnick, further in view of De Ceulaer.

Each of claims 4-16, 11-13, 18-20, and 25-27 depends, whether directly or indirectly, from one of independent claims 1, 8, 15, or 22. The patentable distinctions of independent claims 1, 8, 15, and 22 over Corvin, Wachtfogel, and Plotnick have been discussed hereinabove. De Ceulaer fails to remedy the above-identified deficiencies of

¹³ See August 27, 2009 Office Action, page 4.

¹⁴ 35 U.S.C. 112, fourth paragraph.

Corvin, Wachtfogel, and Plotnick in disclosing all elements of independent claims 1, 8, 15, and 22. Because dependent claims inherently include all of the features of the claims on which they depend, dependent claims 4-16, 11-13, 18-20, and 25-27 are patentably distinguished over the cited art for at least the same reasons as presented hereinabove with respect to independent claims 1, 8, 15, and 22. Accordingly, withdrawal of the rejections of dependent claims 4-16, 11-13, 18-20, and 25-27 is warranted, and is respectfully requested.

F. *The Rejections of Dependent Claims 7, 14, 21, and 28 Should be Withdrawn*

In the August 27, 2009 Office Action, claims 7, 14, 21, and 28 were rejected under 35 U.S.C. 103 as being unpatentable for obviousness over Corvin in view of Wachtfogel, Plotnick, and De Ceulaer, further in view of Koeppele.

Each of claims 7, 14, 21, and 28 depends, whether directly or indirectly, from one of independent claims 1, 8, 15, or 22. The patentable distinctions of independent claims 1, 8, 15, and 22 over Corvin, Wachtfogel, and Plotnick have been discussed hereinabove. De Ceulaer and Koeppele fail to remedy the above-identified deficiencies of Corvin, Wachtfogel, and Plotnick in disclosing all elements of independent claims 1, 8, 15, and 22. Because dependent claims inherently include all of the features of the claims on which they depend, dependent claims 7, 14, 21, and 28 are patentably distinguished over the cited art for at least the same reasons as presented hereinabove with respect to independent claims 1, 8, 15, and 22.

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CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the now-pending claims are in condition for allowance. Examination of all pending claims and issuance of a notice of allowance are earnestly solicited. Should any issues remain that may be amenable to telephonic resolution, the examiner is invited to telephone the undersigned attorneys to resolve such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

Respectfully submitted,

By: /vincent k. gustafson/
Vincent K. Gustafson
Registration No.: 46,182

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
P.O. Box 14329
Research Triangle Park, NC 27709
Phone: 919-419-9350

For: Kevin C. Ecker
Registration No.: 43,600
Phone: (914) 333-9618

Please direct all correspondence to:

Kevin C. Ecker, Esq.
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001